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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/632,928 | 08/04/2000 | KAREN J. WATSON-STRAUGHAN | P-HP 3808 | 2678 |

7590

05/06/2003

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EXAMINER

BARTS, SAMUEL A

ART UNIT

PAPER NUMBER

1621

13

DATE MAILED: 05/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/632,928

Applicant(s)

Straughan et al

Examiner

Samuel A Barts

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

P r i d f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/20/2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disp sition of Claims

- 4) ☒ Claim(s) 1,3-19,43-47 is/are pending in the application.
- 4a) Of the above claim(s) 6,10,14,16,18 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 43-44 is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-8,11,13,45-47 is/are rejected.
- 7) ☒ Claim(s) 9,12,15,17,19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Arguments

1. Applicant's arguments, filed February 20, 2003 have been fully considered and are found unpersuasive. Applicant has stated that the compound pointed out by the Examiner in the previous office, as anticipating the claims, does not exist in the reference. Applicants point to example 28 of US 5,670,479 as being the closest related compound. Applicant makes the assertion that the compound of example 28 is not within the scope of the claimed invention since the compound has branched amino groups. This finding only relates to the final product made in example 28. Applicant missed the pertinent fact that the reactant used in example 28 is actually the compound that reads on the claimed invention. (i.e. 1-(p-nitrobenzyl)diethylenetriamine trihydrochloride) See the first line of the example.

The examiner is repeating this rejection as well as adding another rejection to address claims that were incorrectly withdrawn from consideration.

Allowable Subject Matter

2. Claims 9,12,15,17 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 43 and 44 are allowed.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 8, 11, and 13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by

Abelman et al

Abelman et al teach a compound which embraces the claimed genus.

Abelman et al disclose a compound which reads on the genus when $n=0$, $R1-R2=R4-R7=$ hydrogen, $R8= X-CH-Y$, $X=$ hydrogen, $Y=CH_2-NH_2$. See example 28.

4. Claims 1, 8, 11, 13 and 45-47 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lane et al (US 3,376,344).

Lane et al teach a compound which embraces the claimed genus.

Lane et al disclose a compound which reads on the genus when $n=1$, $R1-R7=$ hydrogen, $R8= X-CH-Y$, $X=$ hydrogen, $Y=CH_2-NH_2$. See column 4 lines 68-69.

Status of Claims

5. Claims 1, 3-5, 7-8, 11, 13 and 45-47 are rejected.

Claims 6, 10, 14, 16 and 18 are withdrawn from consideration as not being directed to the elected invention.

Claims 9,12,15,17 and 19 are objected to as directed to allowable subject matter.

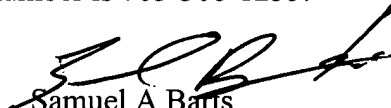
Claims 43 and 44 are allowable

Final paragraph

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel A Barts whose telephone number is 703-308-4630. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johan Richter can be reached on 308-1235. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Samuel A Barts
Primary Examiner
Art Unit 1621

s.b.
May 5, 2003